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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,119	12/21/1998	ANDREW M. PROEHL	80398-P158	3529

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT PAPER NUMBER

2623

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/218,119

Applicant(s)

PROEHL ET AL.

Examiner

Hunter B. Lonsberry /

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-18, 21-32, 36, 37, 43-52 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18, 21-32, 36, 37, 43-52 and 57-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 3/3/06 have been fully considered but they are not persuasive.

The Declaration filed on 3/3/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Dougherty reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Dougherty reference to either a constructive reduction to practice or an actual reduction to practice. Evidence is missing to prove on the part of the applicant to establish diligence. While the declaration does provide a listing of the applications worked on by Ms. Sobrino during the critical period, there is no statement, <sup>nor</sup> ~~not~~ evidence provided which supports that Ms. Sobrino worked diligently on the cases in chronological order, as required by the MPEP section 2138.06 [R-1]. Therefore, the Examiner has maintained the rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11-18, 21-30, 36-37, 46-48, 50-52, and 58-60 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent 6,725,461 to Dougherty.

Regarding claim 11, Dougherty discloses in figure 4, a method for executing by a processor system local to a viewer to alert the viewer of a program (column 10, lines 14-16), said method comprising:

Receiving a first signal (step 401) generated by a viewer during a broadcast of an advertisement of an upcoming program (column 10, lines 14-16, 23-30), the broadcast program may be a commercial advertisement for a future broadcast event on the same or another channel);

Issuing a first notification (step 402) in response to said first signal, said first notification presenting a menu to the viewer (column 10, lines 34-49), the menu (figure 5) comprising indications of viewer interest (yes) and disinterest (no) in viewing the broadcast of the program;

Receiving a second signal (step 403) indicating viewer menu selection, the second signal being generated by the viewer responding to the first notification (column 10, lines 45-49),

Retrieving program information in response to the received second signal indicating viewer interest (step 404, column 10, lines 55-58),

Storing the program information in the processor system local to the viewer (step 404, column 10, lines 55-58), and

At approximately time of broadcast of the program, issuing a second notification to notify the viewer of the broadcast of the program (step 406, column 10, line 58-column 11, line 16, figure 6).

Regarding claim 12, Dougherty discloses that the receiver tunes to the program when the user elects to view the program in response to the second notification (column 11, lines 55-62).

Regarding claim 13, Dougherty discloses that the second notification is displayed on a user display 218 (figures 2,6).

Regarding claim 14-16, 18, 23-24, 27-28, Dougherty discloses in figure 6, a second notification, with yes (viewer interest) or no (viewer disinterest) buttons, a user may select the button by pressing the corresponding yes button on the remote control to view the program and the receiver then tunes to the channel carrying the program (column 10, lines 41-49, column 11, lines 55-62).

Regarding claim 17, Dougherty discloses that the time at which the second notification is derived from the program information retrieved (column 10, lines 58-61).

Regarding claim 21, Dougherty discloses in Figure 2, an apparatus 120 local to a viewer comprising:

a first receiver 202 configured to receive broadcast signals (column 7, lines 36-39);

a second receiver 222 configured to receive at least one control signal (column 8, lines 50-55);

a controller coupled to the first receiver and second receiver (processor 210 in conjunction with data extractor 206 (column 7, lines 45-60), said controller configured to retrieve program information in response to receipt of the control signal indicating viewer interest (column 10, lines 55-58), store the program information local to the viewer (column 10, lines 55-58), and issue, at approximately a time of broadcast, a notification to the viewer of the broadcast of the program (column 10, line 58-column 11, line 11), the controller further configured to receive a first signal generated by a user during broadcast of an advertisement of the program (column 10, lines 14-16, 23-30, the broadcast program may be a commercial advertisement for a future broadcast event on the same or another channel), and generate a second notification in response to receiving the first signal (column 11, lines 55-62), the second notification presenting a menu to the viewer, the menu (figure 6) comprising indications of viewer interest (yes button) and disinterest (no button) in viewing the broadcast of the program, wherein said control signal is generated by the viewer responding to the second notification and indicates viewer menu selection (column 11, lines 57-62).

Regarding claim 22, Dougherty discloses that overlay generator 216 overlays the notifications over the currently tuned broadcast program (column 8, lines 44-49, column

10, lines 14-16, 23-30, the broadcast program may be a commercial advertisement for a future broadcast event on the same or another channel).

Regarding claim 25, Dougherty discloses that the receiver 224 tunes to the program after the user elects to view the program (column 11, lines 55-62).

Regarding claim 26, Dougherty discloses that the second notification is displayed on a user display 218 (figures 2,6).

Regarding claim 29, Dougherty discloses in figure 6, a notification, with yes (viewer interest) or no (viewer disinterest) buttons, a user may select the button by pressing the corresponding yes button on the remote control to view the program and tuner 202 then tunes to the channel carrying the program (column 10, lines 41-49, column 11, lines 55-62).

Regarding claim 30, Dougherty discloses that the time at which the second notification is derived from the program information retrieved (column 10, lines 58-61).

Regarding claim 36, Dougherty discloses a computer readable medium containing executable instructions (figure 4, column 7, lines 46-57), when executed by a processor system local to a viewer, causes the processing system to perform

operations to alert the viewer of a program (column 10, lines 14-16), said method comprising:

Receiving a first signal (step 401) generated by a viewer during a broadcast of an advertisement of an upcoming program (column 10, lines 22-29);

Issuing a first notification (step 402) in response to said first signal, said first notification presenting a menu to the viewer (column 10, lines 34-49), the menu (figure 5) comprising indications of viewer interest (yes) and disinterest (no) in viewing the broadcast of the program;

Receiving a second signal (step 403) indicating viewer menu selection, the second signal being generated by the viewer responding to the first notification (column 10, lines 45-49),

Retrieving program information in response to the received second signal indicating viewer interest (step 404, column 10, lines 55-58),

Storing the program information in the processor system local to the viewer (step 404, column 10, lines 55-58), and

At approximately time of broadcast of the program, issuing a second notification to notify the viewer of the broadcast of the program (step 406, column 10, line 58-column 11, line 16, figure 6).

Regarding claim 37, see claim 12.



Regarding claims 46, 50, and 58, Dougherty discloses that the processing system controls a display 218 (figure 2).

Regarding claims 47, 48, 51, 52, 59 and 60, Dougherty discloses that a user uses a remote control to interact with the STB and make selections to set reminders (column 8, lines 50-62, column 10, lines 41-49).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 31-32, 43-45, 49 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,725,461 to Dougherty in view of U.S. Patent 5,699,107 to Lawler.

Regarding claim 31, Dougherty discloses in figures 5/6, a system in which a user indicates interest by selecting a yes or no option for setting a reminder for an upcoming broadcast via a downloaded application 115.

Dougherty fails to disclose the use of an electronic program guide by which a user indicates interest.

Lawler discloses in figure 6, an EPG with a reminder window 136, that a user uses to indicate interest in a show by selecting a record or remind button (figure 4, column 10, lines 1-26, 60-column 11, line 3), thus enabling a user to search out shows of interest and set a reminder to view the show in the future so that the user doesn't miss the program.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the reminder system of Dougherty to make use of a program guide, as taught by Lawler, thus enabling a user to search out shows of interest and set a reminder to view the show in the future so that the user doesn't miss the program.

Regarding claim 32, Dougherty discloses in figures 5/6, a system in which a user indicates interest by selecting a yes or not option for setting a reminder for an upcoming broadcast via a downloaded application 115.

Dougherty fails to disclose the use of a calendar identifying at least one program of interest to the viewer.

Lawler discloses in figures 2 and 6, a calendar (with dates 104/106, a viewer may view reminders and program information on a date other than the current date, column 8, lines 10-20, column 13, lines 7-16, thus providing a calendar function as a calendar is a sequential list of dates and the user may browse the various dates) with which a user can set a reminder, a reminder icon appears within the calendar so that a user can readily determined which programs have reminders set and which do not and when they occur (column 13, lines 7-16).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Dougherty to utilize the calendar of Lawler, thus enabling a user to determine which programs have a reminder set and when the reminder is to occur.

Regarding claims 43 and 49, Dougherty discloses in figures 5/6, a system in which a user indicates interest by selecting a yes or not option for setting a reminder for an upcoming broadcast via a downloaded application 115.

Dougherty fails to disclose a recording option, which is displayed in the first notification.

Lawler discloses in figure 4A, that a user presses an action button which results in a display of a first notification 238 which displays a menu (figure 6) with a record option 130 which records the program when it is broadcast (column 10, lines 38-44, line 60-column 11, line 17), thus ensuring that a user would be able to view a program of interest at a later time.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Dougherty to utilize the recording option of Lawler, thus ensuring that a user would be able to view a program of interest at a later time.

Regarding claims 44-45, and 57, Dougherty discloses in figures 5/6, a system in which a user indicates interest by selecting a yes or no option for setting a reminder for an upcoming broadcast via a downloaded application 115.

Dougherty fails to disclose a recording option, which is displayed in the second notification.

Lawler discloses a reminder system, in which a user can elect to record the program instead of receiving a reminder (column 10, lines 38-44, line 60-column 11, line 17), thus ensuring that a user would be able to view a program of interest at a later time.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the second notification of Dougherty to utilize the recording option of Lawler, thus ensuring that a user would be able to view a program of interest at a later time.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HBL



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